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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/760,965	01/20/2004	Steven W. Ek	STD 00.01 CIP2 CON	1498
32047	7590	11/06/2006	EXAMINER	
GROSSMAN, TUCKER, PERREAULT & PFLEGER, PLLC 55 SOUTH COMMERICAL STREET MANCHESTER, NH 03101			PHIOGENE, PEDRO	
			ART UNIT	PAPER NUMBER
			3733	

DATE MAILED: 11/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

NT

**Office Action Summary****Application No.**

10/760,965

**Applicant(s)**

EK, STEVEN W.

**Examiner**

Pedro Philogene

**Art Unit**

3733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 October 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 55-71 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 69-71 is/are allowed.
- 6) ☒ Claim(s) 55-68 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 55-71 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-66 of U.S. Patent No. 6,679,917. Although the conflicting claims are not identical, they are not patentably distinct from each other because it is clear that all the elements of claims 55-71 are to be found in claims 1-66. The difference between claims 55-71 of the application and claims 1-66 of the patent lies in the fact that the patent claims include many more elements and are thus much more specific. Thus the invention of claims 1-66 of the patent is in effect a "species" of the "generic" invention of claims 55-71. It has been held that the generic invention is "anticipated" by the "species". See *In re Goodman*, 29 USPQ2d 2010 (Fed.

Art Unit: 3733

Cir. 1993). Since claims 55-71 are anticipated by claims 1-66 of the patent, they are not patentably distinct.

Claims 55-71 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-13 of U.S. Patent No. 6,520,964.

Although the conflicting claims are not identical, they are not patentably distinct from each other because it is clear that all the elements of claims 55-71 are to be found in claims 1-13. The difference between claims 55-71 of the application and claims 1-13 of the patent lies in the fact that the patent claims include many more elements and are thus much more specific. Thus the invention of claims 1-13 of the patent is in effect a "species" of the "generic" invention of claims 55-71. It has been held that the generic invention is "anticipated" by the "species". See *in re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993). Since claims 55-71 are anticipated by claims 1-13 of the patent, they are not patentably distinct.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 55-68 are rejected under 35 U.S.C. 102(e) as being anticipated by Schwartz et al. (6,2512,143).

Art Unit: 3733

With respect to claims 55-68, Schwartz et al disclose an implant (10) comprising a bone-facing distal surface, a proximal surface and a protrusion formed by an extension of the bone-facing distal surface and the proximal surface; as best seen in FIGS.7, 8, 10-25. A radial ring extending from the distal end, the protrusion comprises an extension from the radial ring and an extension of the proximal surface the radio ring comprises at least one radio slot; as best seen in FIGS. 21-25; the protrusion is adapted to cover a portion of an un-excised articular surface, and wherein a distal surface of the protrusion has a shape based on the un-excised articular surface; as set forth in column 3, lines 49-59; and as best seen in FIGS.8, 10. The radial ring comprises an arcuate edge and the protrusion comprises an extension from the arcuate edge; as best seen in FIGS. 2, 13B, 25, 45. The implant having a truncated circular shape, the truncated circular shape comprises a circular shape truncated on two opposed sides, first and second side surfaces extending at least from each of the truncated opposed sides to the distal surface, as best seen in FIGS.29-35.

### ***Allowable Subject Matter***

Claims 69-71 are allowed.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

5,624,463	04-1997	Stone et al.
5,580,353	12-1996	Mendes et al.

Art Unit: 3733


5,632,745	05-1997	Schwartz
6,540,786	04-2003	Chibrac et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pedro Philogene whose telephone number is (571) 272-4716. The examiner can normally be reached on Monday to Friday 6:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on (571) 272 - 4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Pedro Philogene  
July 20, 2006

  
PEDRO PHILOGENE  
PRIMARY EXAMINER